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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,131	06/27/2003	Chi-Yu Ho	10461-US-PA	1130

31561 7590 11/16/2005

JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE
7 FLOOR-1, NO. 100
ROOSEVELT ROAD, SECTION 2
TAIPEI, 100
TAIWAN

EXAMINER

HOLTON, STEVEN E

ART UNIT PAPER NUMBER

2673

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,131

Applicant(s)

HO ET AL.

Examiner

Steven E. Holton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's election filed on 11/3/2005. Claims 1-11 are currently pending in the application. An action follows below:

Election/Restrictions

2. Applicant's election without traverse of species I in the reply filed on 11/3/2005 is acknowledged.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Taiwan, R.O.C. on 12/31/2002. It is noted, however, that applicant has not filed a certified copy of the 91137983 application as required by 35 U.S.C. 119(b).

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The disclosure is objected to because of the following informalities:

The brackets enclosing the title are non-standard and should be removed in an amended and more descriptive title;

Paragraph 25, lines 4, 13, 16, and 19, the use of a double quotation mark “ should be a single quotation mark ‘ in the use with the possessive case;

Paragraph 27, lines 9 and 16, the same error as in paragraph 25, use of a double quotation mark instead of a single quotation mark.

Paragraph 27, line 11 the symbol following the value 50 is a non-standard symbol and not understood. The Examiner assumes that the symbol was intended to be kΩ, standing for kilo-ohms, which are a common measurement unit for resistance.

Appropriate correction is required.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “backlight” named in claims 1, 4 and 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites the limitation of "a metal slice, located on the surface of the hand-held apparatus, wherein when a user touches the metal slice, the metal slice generates an AC signal". As stated by the applicant, it appears that the metallic slice is capable of generating an AC signal through some undisclosed property of the metal, that is, the signal is created by the metal slice. If that is the case, the applicant has not explained how this signal is generated in such a manner that one skilled in the art could

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practice the invention. What type of compound is the metal slice? Is it a complex alloy of different metals? Is it a specific element? How would one produce such a metal slice? Are the physical dimensions of the metal slice important to the production of the AC signal?

For the purposes of the following rejections, the Examiner assumes that the metal slice generating an AC signal as described by the applicant refers to the known affect of the human body transmitting the power signal transmitted within the surrounding power grid (standard electrical power being sent through power lines to electrical sockets and outlets). The signal is coupled to the human body and can be measured. When a person touches a metallic object this AC power signal is transmitted to the metal. In the case of the United States, the power grid operates at a standard 60 Hz cycle and the measured signal in an object touched by a person would be show a 60 Hz signal.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta (USPgpPub: 2002/0163524) in view of Adelson et al. (USPN: 3530312), hereinafter Adelson.

Regarding claim 1, Dutta discloses a handheld electronic device with "a display (Fig. 1, element 101; paragraph 23), comprising a backlight (paragraph 23; The examiner notes that Dutta does not show the backlight, but a backlight is part of the device, otherwise the backlight switch wouldn't be necessary)." However, Dutta does not disclose "a metal slice, located on the surface of the hand-held apparatus, wherein when a user touches the metal slice, the metal slice generates an AC signal; and

A control circuit, coupled to the metal slice, used to convert the AC signal into a DC pulse signal so as to control the hand-held apparatus based on the DC pulse signal."

Adelson discloses a touch responsive circuit that functions using "an antenna element comprising a body portion of the electrically conductive material which can assume many shapes, forms a touch responsive element (col. 3, lines 6-9; Fig. 1, element 5)". The Examiner notes that the antenna could be a metal slice or panel on

the surface of a device. Further, when the antenna is touched; an AC is coupled through the human body to the rest of the circuit for use as a switch signal (col. 4, lines 25-65).

At the time of invention it would have been obvious to one skilled in the art to utilize touch switches of Adelson as a type of switch used for controlling the hand-held device of Dutta. The motivation for doing so would have been "to provide a construction of electronic switch which has no moving parts, and an indefinitely long operating lifetime... the switch has a switching time in the microsecond range (Adelson, col. 2, lines 32-38)." The Examiner notes that the output of the Adelson circuit is shown as being a both half-rectified and fully-rectified (Figs. 3 and 4), but Adelson does not discussed changing the signals to DC pulse signals. However, it would have been obvious to one skilled in the art that a microprocessor operates with DC signal inputs and that conversion of the AC signal output by Adelson's switch to a DC signal for use with a microprocessor would be possible Regarding claims 2 and 3, the Examiner takes Official Notice that it is old and well known to provide a switch to turn a display on and off for the user of a handheld device to manipulate. It would have been obvious to one skilled in the art to provide a switch such as Adelson's on a handheld device so that a user could turn the display device on or off by manipulating the button.

Regarding claims 4 and 5, Dutta discloses a physical button on the handheld device for turning the backlight on and off (Fig. 1, element 104; paragraph 23). Thus, it would have been obvious for one skilled in the art to use a touch sensitive switch such as Adelson's as the backlight control switch as disclosed by Dutta.

Regarding claims 6 and 7, the Examiner takes Official Notice, that it is well known in the art to provide a keyboard lock switch on handheld and portable devices so that when unauthorized users are not allowed to enter text on the device or that keyboard input will be ignored when the device is not being operated and is being carried. Such a locking mechanism for the keyboard of a handheld device is done using a switch on the handheld device. Thus, it would have been obvious for one skilled in the art to use the switch of Adelson as a switch to operate the locking and unlocking of the keyboard of a handheld device.

Regarding claim 8, Adelson discloses a rectifier used to rectify the AC signal and output a rectified signal (Figs. 4 and 5, element 13 and element 8; col. 3, lines 56-71 and col. 4, line 67-col. 5, line 9). Adelson does not expressly disclose an amplifier, filter or microprocessor, but the amplification and filtering of an AC signal for use with a microprocessor is known in the art and would be an obvious choice by one skilled in the art to increase the level of the sensed signal and to remove noise from the signal for better operation of the overall circuit. Dutta discloses a microprocessor that is used to operate the handheld device (Fig. 2, element 201; paragraph 24).

Regarding claims 9-11, Dutta discloses a backlight control for a handheld personal digital assistant. The Examiner states that mobile phones, personal digital assistants and handheld computers are analogous within the art and that it would be obvious to one skilled in the art that the backlight control functions and other controls provided by Dutta could be interchangeably provided to a mobile phone or hand-held computer.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goodenough (USPqPub: 2003/0193477) discloses a hand-held keyboard with a keyboard lock function and button.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven E. Holton whose telephone number is (571) 272-7903. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven E. Holton
November 13, 2005
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**VIJAY SHANKAR
PRIMARY EXAMINER**